

REMARKS

Reconsideration of the subject application in view of the present amendment is respectfully requested.

With the present amendment, Claim 3 has been cancelled. Claim 1 has been amended to yet more clearly define the present invention.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance, and action to that end is respectfully requested.

Claims 1-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Schmid*, et al., U.S. Patent No. 4,456,076 (*Schmid*) in view of *Ramarathnam*, U.S. Patent No. 6,320,286 (*Ramarathnam*). Claims 8-10 were rejected as Claims 1-7 above and further in view of *Ranger*, et al., U.S. Patent No. 5,111,890 (*Ranger*). It is respectfully submitted that claims 1,2,4 and 6-10 are patentable over the cited references.

Specifically, claim 1 recites:

- (i) a first, oscillating subassembly including a percussion mechanism (2) and a brushless rotor (5) of the electrical drive;

(ii) a second subassembly including a stator (7) of the electrical drive and a housing; and that

(iii) the first subassembly is supported in the housing for a limited oscillating movement along a tool axis and relative to the second subassembly.

The prior art and *Schmid*, in particular, do not disclose a structure in which an electric drive rotor reciprocates together with the percussion mechanism. In *Schmid*, both the stator of the electric motor (2) and the rotor (9), together with its shaft (10), are located in the housing (1). The rotor shaft (10) is supported for rotation in opposite bearing (11, 11¹) secured in the housing (1). All of the elements that provide for conversion of a rotary movement of the shaft into a reciprocating movement of the drive piston (impactor piston 24) are secured against the axial movement (column 4, lines 19-65). None of the elements is axially displaced with the percussion mechanism. In *Schmid*, the rotor (9) is not axially displaceable relative to the stator (7) which would have been the case if the rotor would have been part of the first subassembly that includes the percussion mechanism.

In view of the above, it is respectfully submitted that *Schmid* does not anticipate or make obvious the present invention, as defined by Claim 1.

Even assuming, *arguendo*, that the universal motor (2) of *Schmid* is replaced with the brushless motor of *Ramarathnam* “for reducing overloads and stalling of the motor,” that would not make the brushless rotor of *Ramarathnam* automatically part of the first subassembly, as the brushless rotor would not be displaceable, together with percussion mechanism relative to the stator secured in the housing.

It is respectfully submitted that prior art, including *Schmid* and *Ramarathnam*, provides neither reason nor motivation for making the rotatable rotor part of the first subassembly that also includes the percussion mechanism.

In view of the above, it is respectfully submitted that modification of an electrical hand-held tool according to which the electric drive rotor forms part of a first subassembly that also includes the percussion mechanism, in order to increase the mass of the first subassembly to thereby reduce the oscillation amplitude of the first subassembly, would not be obvious in view of the prior art and becomes obvious only in view of the present invention.

Since all claim limitations must be considered in an obviousness determination since the combination of *Schmid* and *Ramarathnam* fails to disclose an important and recited feature of independent Claim 1, namely, that the brushless rotor forms part of the first subassembly, it is respectfully submitted the present invention, as defined by Claim 1, is not rendered obvious by the combination of *Schmid* and *Ramarathnam* and is, therefore, patentably defines over said combination, and is allowable.

Claims 2, 4 and 6-10 depend on Claim 1 and are likewise allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawing be further amended or corrected in formal respects, in order to place in case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed issue. Alternatively, should the

Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

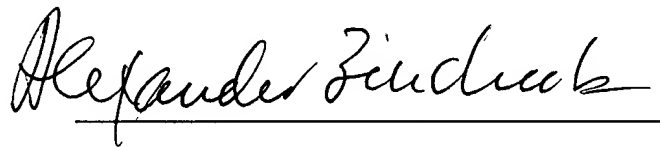
A handwritten signature in cursive script, reading "Alexander Zinchuk", written in dark ink.

Alexander Zinchuk
Reg. No. 30,541

Dated: November 8, 2004

Sidley Austin Brown & Wood LLP
787 Seventh Avenue
New York, NY 10019
Tel.: (212) 839-7365

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail and addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on November 8, 2004.

A handwritten signature in cursive script, reading "Alexander Zinchuk", written in dark ink, positioned above a horizontal line.